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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,397	10/11/2002	Dante Monteverde	33983/400200	2789
27717	7590	09/08/2005	EXAMINER	
SEYFARTH SHAW LLP 55 EAST MONROE STREET SUITE 4200 CHICAGO, IL 60603-5803			OSBORNE, LUKE R	
			ART UNIT	PAPER NUMBER
			2123	

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/065,397

Applicant(s)

MONTEVERDE, DANTE

Examiner

Luke Osborne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-6,8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-6,8 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1, 4-6, 8 have been presented for reconsideration. Claims 2, 3, 7 and 9 have been cancelled. Claim 10 has been added. Claims 1, 4-6, 8, and 10 are now pending in the application. Claims 1, 4-6, 8 and 10 have been rejected.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1, 4-6, 8, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Legh-Smith of record.

Referring to claim 1, Legh-Smith teaches a method of assigning keywords to Internet page as claimed. See Figures 1-4 and the corresponding portions of Legh-Smith's specification, for this disclosure. Refer specifically to Figure 3 and the corresponding portions of the disclosure for the claimed invention. In particular Legh-Smith teaches a method of assigning keywords to an Internet site or Internet page, comprising the steps of:

Providing a topical category database [item 300, Column 4, lines 66-67, Column 5, line 1], said topical category database contains at least one predefined topical category [... comprising headings and categories for inclusion in the database 112. (Fig 2, item 200)];

Assigning at least one keyword to said predefined topical categories [step 302, a list of keywords is generated for each of the categories for inclusion in the category list (Column 5, lines 3-5)];

Providing an Internet site and Internet page database [112], said Internet site and Internet page database contains information relative to at least one Internet site or Internet page [Fig. 4, Column 5, lines 45-48];

Assigning each said Internet page to at least one said predefined topical category [the list of URLs is cross-referenced back with the original description of categories and keywords (Column 5, lines 45-49)], thereby creating as page assigned topical category; and assigning each said Internet page [URL] at least one keyword contained within said keyword list [item 302] for said page assigned topical category.

Applicant Argues

Legh-Smith does not teach a method of assigning, or providing, Internet pages or sites any keyword, based upon the topical category that such Internet sites or pages have been assigned to

Examiners Response

Applicants' arguments are found unpersuasive. Examiner reiterates that Legh-Smith does in fact disclose the limitations as claimed. Legh-Smith states that the URL's are cross-referenced back with the original description of categories and keywords [Column 5, lines 45-50]. It is the Examiners position that this "cross-referencing" **assigns** pages keywords according to their category. In Applicants' arguments dated

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5/18/05, Applicant gives definitions for the terms at question. Examiner agrees with the definitions set forth as ones in concert with one of ordinary skill's knowledge. However, Examiner disagrees with Applicants' assertion that they mean completely different things. The cross-referencing as disclosed is an assignment. The correlation of one part of a work to pertinent information found elsewhere has linked the two pieces of information together in an authoritative or exact manner. Applicants' use of the word assign also links two pieces of information together. One of ordinary skill in the art would recognize the equivalency of the terms.

The rest of Applicants' arguments are found unpersuasive for arguing limitations not found in the claims, or merely asserting the patentable distinction over the art of record.

Referring to claim 4, Legh-Smith teaches the method of claim 1, as above, "wherein each of said predefined topical categories has a title [heading] and a brief synopsis description [associated information (Column 5, lines 5-8)]" as claimed.

Referring to claim 5, Legh-Smith teaches the method of claim 1, as above, "assigning at least one keyword to said predefined topical category [Once (keywords are) provided for each of the categories] based on relatedness [associated information] between said keyword and said predefined topical category [Column 5, line 12, Column 5, lines 5-8]" as claimed.

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Referring to claim 6, Legh-Smith teaches the method of claim 2, as above, “comprising the step of adding any keywords previously assigned to said Internet site to said keyword list [Step 316] for said site assigned topical category [after steps 316, 320, report 322 contains filtered out URL’s to allow periodic checks to be carried out to ensure that good information is not being rejected]” as claimed.

Referring to claim 8, Legh-Smith teaches the method of claim 1, as above. In particular Legh-Smith teaches assigning each said Internet site to at least one said predefined topical category, thereby creating a page assigned topical category, comprising the steps of:

reviewing any previously assigned keywords contained within the meta tag field of said Internet site [step 316, the list of URLs (which as mentioned above is arranged by keyword)];

matching said previously assigned keywords to keywords contained within said keyword list[is cross-referenced back with the original description of categories and keywords, generated in step 302];

assigning said Internet page to the predefined topical category whose keyword list contains matching keywords [to identify those URLs which are candidates for each category].

Claim 10 contains the same limitations as claim 1 thus is rejected for the same reasons as claim 1. The reasons that claim 10 contains the same limitations as claim 1

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is that the recitation of "for an keyword-based Internet search query" is an intended use limitation only found in the preamble.

In response to applicant's arguments, the recitation "for an keyword-based Internet search query" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Osborne whose telephone number is (571) 272-4027. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo P. Picard can be reached on (571) 272-3749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LRO


Paul L. Rodriguez 9/6/05
Primary Examiner
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